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Paper No. 12

Dowell & Dowell, P.C.  
Suite 309  
1215 Jefferson Davis Highway  
Arlington, VA 22202

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OFFICE OF PETITIONS

In re Application of  
Shinagawa, et al.  
Application No. 09/781,309  
Filed: February 13, 2001  
Attorney Docket No. 13599

ON PETITION

This is a decision on the petition under 37 CFR 1.313(b)(1), filed July 13, 2004, to withdraw the above-identified application from issue "based upon a mistake on the part of the Patent Office for failing to consider prior art references submitted in an Information Disclosure Statement" on April 6, 2004.

The petition under 37 CFR 1.313(b)(1) is **dismissed** as inappropriate for the reasons stated below.

37 CFR 1.313(b) states:

Once the issue fee has been paid, the Office will not withdraw the application from issue at its own initiative for any reason except:

- (1) A mistake on the part of the Office;
- (2) A violation of § 1.56 or illegality in the application;
- (3) Unpatentability of one or more claims; or
- (4) For interference.

37 CFR 1.313(c) states:

Once the issue fee has been paid, the application will not be withdrawn from issue upon petition by the applicant for any reason except:

- (1) Unpatentability of one of more claims, which petition must be accompanied by an unequivocal statement that one or more claims are unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable;
- (2) Consideration of a submission pursuant to 37 CFR 1.114; or
- (3) Express abandonment of the application. Such express abandonment may be in favor of a continuing application.

37 CFR 1.313(b) applies to those situations where the Office, at its own initiative, may withdraw an application from issue, but only in those situations which meet the conditions of 37 CFR 1.313(b). See Sampson v. Dann, 466 F.Supp. 965, 973-74, 201 USPQ 15, 22 (D.D.C. 1978). Therefore, 37 CFR 1.313(b) is inapplicable here since the rule does not provide for withdrawal from issue at the request of an applicant.

In view of the alternative petition under 37 CFR 1.313(c)(2) and submission of a Request for Continue Examination (RCE), the petition will be treated on the merits thereof.

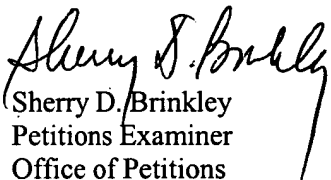
The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

The petition under 37 CFR 1.313(c)(2) is GRANTED.

***Petitioner is advised that the issue fee paid, in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.<sup>1</sup>***

Telephone inquiries relating to this decision should be directed to the undersigned at (703) 305-9220.

After the application is received in the Office of Petitions, the file will be forwarded to Technology Center AU 2624 for further processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed IDS.

  
Sherry D. Brinkley  
Petitions Examiner  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy

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<sup>1</sup>The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: "Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above." Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form must be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).